



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/991,628	11/05/97	STOMINGER	J HAR-001DV

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HM22/0308

EXAMINER

CUNNINGHAM, T

ART UNIT	PAPER NUMBER
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1644

DATE MAILED: 03/08/99

Please find below and/or attached an Office communication concerning this application or
pr ceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/991,628

Applicant(s)
Stominger, J. L.

Examiner
Thomas Cunningham

Group Art Unit
1644



☒ Responsive to communication(s) filed on Dec 16, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 3-19, 22, and 26-29 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 3-19, 22, and 26-29 are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1644

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 3-19 and 22, drawn to compositions comprising peptides, classified in class 424, subclass 185.1.
 - II. Claims 26-29, drawn to a method of identifying foreign antigens (no specific physically definite steps recited, e.g. contacting HLA-DR with an antibody or peptide), classified in class 435, subclass 7.1.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to compositions comprising peptides (Group I) and to a method having no physically definite steps (Group II) that does not appear to have any relationship to the peptides of Group I. If the "peptide sequences" of step (5) of claim 26 are intended to be the same as the peptides used in the compositions of Group I, then they are distinct as the same peptides could be identified by alternative means, such as by elution from HLA-DR molecules or fragmentation of known antigens or by direct synthesis. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper. Applicant is advised that the

Art Unit: 1644

reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

3. Claims 3-19, 22, and 26-29 are generic to a plurality of disclosed patentably distinct species comprising:

For Group I: peptides with materially different sequences, e.g. SEQ ID NO: 1, 2, etc. Applicant is required to elect one structurally defined species of peptide, e.g. SEQ ID NO: 1.

For Group II: methods involving different HLA-DR molecules, different binding pockets, different sequence motifs and different antigens. Applicant is required to elect a species of method and define each relevant parameter, e.g. type of HLA-DR molecule, identify the first major binding pocket and the second major binding pocket, the sequence motif and the identity of the antigen. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

Art Unit: 1644

amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Cunningham whose telephone number is (703) 308-3968.



THOMAS M. CUNNINGHAM
PRIMARY EXAMINER
GROUP 1800

March 4, 1999